

38. (New) The method of providing a selective narrative data base and system of claim 37, wherein said figurine is a stuffed figurine.

II. REMARKS

1. Claim Rejections – Double Patenting

Applicant's claims 1-20 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent Application No. 09/943,014 ('014). As recommended by the Office Action, a Terminal Disclaimer was timely filed for the '014 Patent Application in compliance with 37 CFR 1.321©) to overcome the double patenting rejection.

2. Claim Rejections – 35 U.S.C. § 103

Applicant's Claims 1-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drosset et al (US Patent No. 6,662,231) in view of Brelis et al (US Patent No. 6,544,040). Applicant's Claim 1 is herein amended to overcome the § 103(a) rejection. Applicant's Claims 2-8, claims dependent upon Claim 1, remain in the application for reconsideration in view of the amended Claim 1.

3. Claim Rejections – 35 U.S.C. § 103

Applicant's Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drosset et al (US Patent No. 6,662,231) in view of Brelis et al (US Patent No. 6,544,040) in further view of Schiller et al. (US Patent No. 6,442,573). Applicant's Claims 9 and 10, claims dependent upon Claim 1, remain in the application for reconsideration in view of the amended Claim 1.

4. Claim Rejections – 35 U.S.C. § 103

Applicant's Claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drosset et al (US Patent No. 6,662,231) in view of Brelis et al (US Patent No. 6,544,040) in further view of Peterson et al. (US Patent No. 5,825,876). Applicant's Claims 11-13, claims dependent upon Claim 1, remain in the application for reconsideration in view of the amended Claim 1.

5. Claim Rejections – 35 U.S.C. § 103

Applicant's Claims 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Drosset et al (US Patent No. 6,662,231) in view of Brelis et al (US Patent No. 6,544,040) in further view of Peterson et al. (US Patent No. 5,825,876). Applicant notes that the office action comments regarding Claims 15-19 make reference to Gabai, identified in the Notice of

References Cited as US Patent 6,368,177. Responses to these issues based Drosset et al in view of Brelis et al, and further in view of Gabai, are discussed below accordingly.

For Applicant's invention to be unpatentable over Drosset et al in view of Brelis et al, and further in view of Gabai, a *prima facie* case of obviousness must be established by showing that three basic criteria are met. "First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. Second, there must be a reasonable expectation of success. Finally, when combined, the prior art references must teach or suggest all the claim limitations." MPEP § 2143. It should also be noted that "[t]he mere fact that the references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of such combination." MPEP § 2143 citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). All three criteria must be established to show *prima facie* obviousness, and the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in the Applicant's disclosure.

Gabai teaches a method and apparatus for a system that uses radio signals to transfer audio signals to a toy, animated character, or like character on a screen, in order to produce sound, such as recorded or synthesized speech, in connection via a public network to at least one server. Specifically, Gabai teaches a toy having interactive functionality in connection to a public server having transactional functionality, such as effecting sales over a public network. As such, Gabai teaches away from combining a system and method having a toy that produces

speech in the form of a narrative obtained from a subscriber-based audio service. Audio files received from a narrative data base as provided in the present invention application, whether received in real-time or in a compressed file format, are not conducive to the transactional interactivity, such as sales and enhancement of television ratings, as taught by Gabai. Subscriber-based audio services, particularly those of the present invention, provide a unidirectional transmission of audio signals that would not allow transactional interactivity.

Drosset teaches a method and system for providing audio service to a client through a communication network, including the provision of audio files on a subscriber basis, but does not suggest or motivate one to transmit the audio files to a third location, as to a receiving means within a toy.

The Applicant respectfully asserts that a *prima facie* case of obviousness has therefor not been established here, where there is a lack of suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references of Drosset et al and Gabai.

III. CONCLUSION

A Terminal Disclaimer was timely filed for the '014 Patent Application in compliance with 37 CFR 1.321©) to overcome the double patenting rejection of claims 1-20. Applicant notes that claims 14 and 20 were only rejected as unpatentable under the doctrine of

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obviousness-type double patenting, and so remain in the application for reconsideration in view of the filed Terminal Disclaimer.

Three amendments have been made to the Specification to correct grammatical errors.

Claim 1, as amended, remains in the application for reconsideration. Claims 2-13, as amended, remain in the application for reconsideration in view of amended Claim 1. Claims 14-16 have been deleted from the present application. Claims 17-19, as amended, remain in the application for reconsideration in view of amended Claim 1. Claim 20 remains in the application. New Claims 21-38 have been presented here for examination.

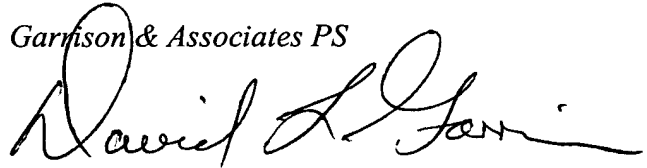
By the foregoing amendments and remarks, Applicant believes that he has responded fully to all of the concerns expressed in the office action. It is believed that the claims, as set forth above, comply fully with the Examiner's comments and favorable action in the form of a Notice of Allowance is respectfully urged.

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Should the Examiner find that any matters remain for resolution, he is respectfully
requested to contact the undersigned by telephone at (206) 441-3440.

Respectfully submitted,

Garrison & Associates PS

A handwritten signature in black ink, appearing to read "David L. Garrison". The signature is fluid and cursive, with the first name "David" being the most prominent.

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